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10/016,079	12/12/2001	Yutaka Hasegawa	SUZU:002	6932

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EXAMINER	
BOVEJA, NAMRATA	

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/016,079	HASEGAWA, YUTAKA	
	Examiner	Art Unit	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 10/18/2007.

2. Claims 1-20 are presented for examination.

3. Amendments to claims 1-20 have been entered and considered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 9, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the claim introduces the limitation "wherein the secondary work by the one user is a modified version of a digital content provided by the content proprietor," and this constitutes new matter, as this claim limitation is not supported by the specification. Applicant has also failed to identify any support for this limitation in the submitted amendment. Clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-*20*, are rejected under 103(a) as being anticipated by Yamanaka et al. (Publication Number US 2001/0016834 A1 hereinafter Yamanaka) in view of the article titled "Imagine Radio Debuts a New Generation of Customized Radio," from the PR Newswire published on August 24, 1998 on pg. 1 (hereinafter ImgRadio) and further in view of Official Notice.

Disclaimer: Claims 1, 5, 9, and 13 were found to be deficient under U.S.C. 112 first paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claims 1, 5, 9, and 13, Yamanaka discloses the method, system, a machine-readable medium, and a computer program for managing an information service, which handles contribution and distribution of digital contents and presentation of advertising messages to users of the information service via plurality of user terminals including first and second user terminals over a computer network (abstract and page 1 paragraphs 12-16), the system comprising: a first database containing advertising messages provided from advertisers (page 1 paragraph 16, page 6 paragraph 117, page 10 paragraph 181, page 15 paragraphs 258, 263, and 264, page 16 paragraphs 271-273, and Figures 4, 5, 14, 15, 23, and 27) that subscribe to the information service with payment of advertisement fees (page 1 paragraph 17, page 2 paragraph 25, page 9 paragraph 153, page 11 paragraph 184, and page 12 paragraph 198); a

second database containing a plurality of digital contents which are subject to legal protection on behalf of content proprietors (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28); a delivering section that delivers the advertising messages over the computer network to the users via the plurality of user terminals (page 7 paragraph 119, page 9 paragraph 162, page 15 paragraphs 263 and 264, page 16 paragraphs 271-276, and Figures 7 and 8); another delivering section that delivers the registered digital content to another of user via the second user terminal when receiving the request from the another user over the computer network (page 6 paragraph 118 to page 7 paragraph 119, page 8 paragraph 134, page 9 paragraph 152, page 15 paragraphs 261-262, and page 16 paragraph 284); and an allocating section that allocates at least a part of the advertisement fees collected from the subscribing advertisers to the content proprietor of the registered digital content identified in the status information (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraph 142, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20); a receiving section that receives digital content from one of the users via the first user terminal wherein the users are different from the identified content proprietors (page 8 paragraphs 138 and 139, page 11 paragraph 190, page 20 paragraph 343, and Figure 15).

Yamanaka is silent about creating a secondary work by the one user, who is different from the identified content proprietor, *wherein the secondary work by the one user is a modified version of a digital content provided by the content*

proprietor. ImgRadio teaches creating as a secondary work by the one user, who is different from the identified content proprietor (i.e. a user creates his own radio station by selecting songs by various artists and enables others to access his radio station) (page 1 paragraph 3, page 2 paragraphs 9-12 and 15), *wherein the secondary work by the one user is a modified version of a digital content provided by the content proprietor (i.e. modified version can be playing songs from different CD's, playing songs in a different order or with different frequency, playing songs in a way that provides for simpler access such as by an artist name, genre, or a rating assigned to the artists, or even using a pre-formatted station and modifying it, since the dictionary definition of the word version is simply a particular form or variation of an earlier or original type, i.e. a variation from an original CD is therefore a modified version) (page 1 paragraphs 3 and 4 and page 2 paragraphs 6-10).* It would have been obvious to Yamanaka to include creating a secondary work by the one user, who is different from the identified content proprietor *wherein the secondary work by the one user is a modified version of a digital content provided by the content proprietor* to enable users to share their favorite contents with their family members and thereby help promote referral business.

Yamanaka is also silent about the receiving section receiving a digital content from one of the users via the first user terminal together with status information indicating that received digital content is subject to the legal protection and identifying a content proprietor of the received digital content. Official Notice is taken that it is old and well known to indicate the status

information for digital content by graphics arts companies to ensure that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign. Furthermore, it's old and well known for users to include status information and content proprietor information as done by those users who may be providing free downloads from their websites for computer programs, to ensure that proper credit goes to the developer and owner of the program and not the distributor of the program and to protect the user from any liability associated with misrepresenting and marketing the content as being his own rather than belonging to the actual developer of the program.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner and to ensure that the owner of the proprietary content receives credit for the content and not the distributor of the content. Furthermore, it would have been obvious to do this in order to ensure payment to the content holder by the distributor for paid content as indicated by the data presented from the execution key associated with a particular content

holder for the number of times the content was executed by a user can be made quickly and accurately.

6. In reference to claims 2, 6, 10, and 14, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains protected digital contents subject to legal protection (i.e. content owned by creators and holders excluding distributors that requires the use of an execution key) and non-protected digital contents not subject to legal protection (i.e. content owned by distributors that also may not required the use of an execution key) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28), such that the allocating section allocates the collected advertisement fees to the proprietors (i.e. content creators and holders excluding distributors based on the number of times the content was executed as tracked by the execution key) only when the protected digital contents are delivered to the users via the user terminals (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

7. In reference to claims 4, 8, 12, and 16, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains a multiple of digital contents subject to legal protection on behalf of the same proprietors (i.e. multiple songs by the same artists or from the same CD for which creators and holders own the rights, multiple game titles

by the same manufacturer of the game CD's, and multiple movies by the same movie director) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 7 paragraph 126, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 7, 8, 23, 27, and 28) such that the allocating section allocates a part of the collected advertisement fees to the same proprietor when any of the multiple of the digital contents is delivered to the users via the user terminals (i.e. pay the proprietors according to each song download on a per song basis regardless if more than one song from the same artist is downloaded or even if the same song is downloaded more than once) (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 7 paragraph 131, page 8 paragraphs 142-143, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

8. In reference to claims 3, 7, 11, and 15, Yamanaka discloses a system, method, a machine readable medium, and computer-readable storage device wherein the allocating section allocates the collected advertisement fees only if registered (i.e. accepted or obtained or under contractual agreement) (page 4 paragraph 67) digital content is delivered under the legal protection (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

Yamanaka doesn't specifically teach the use of status information (i.e. presence information for indicating contents subject or not subject to legal

protection) indicating whether or not the contributed digital contents are subject to the legal protection. Official Notice is taken that it is old and well known to indicate the status information for digital content by graphics arts companies to ensure that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner.

9. *In reference to claims 17-20, Yamanaka the system wherein the digital content is music (page 1 paragraph 2 and page 8 paragraph 139).*

Response to Arguments

10. After careful review of Applicant's remarks/arguments filed on 10/18/2007, the Applicant's arguments with respect to claims 1-20 are presented for examination and have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have been entered and considered.

11. A new U.S.C. 112 rejection for claims 1, 5, 9, and 13 has been introduced as necessitated by the Applicant amendment.

12. In reference to claims 1, 5, 9, and 13, Applicant argues that the station created by the user in the ImgRadio article is not a secondary work of another, because it does not require any permission from anyone and is not a modification of anything. Furthermore, the Applicant argues that a playlist or station does nothing to change the content of the station, and is therefore not a secondary work of another. With respect to this, the Examiner respectfully disagrees with the Applicant. Specifically, Applicant's claims recite that a secondary work by the one user is a modified version of a digital content provided by the content proprietor. Therefore, a modified version of digital songs can be playing songs from different CD's, playing songs in a different order or with different frequency, playing songs in a way that provides for simpler access such as by an artist name, genre, or a rating assigned to the artists, or even using a pre-formatted station and modifying it, since the dictionary definition of the word version is simply a particular form or variation of an earlier or original type, i.e. a variation from an original CD is therefore a modified version, and this is taught by the ImgRadio reference on page 1 paragraphs 3 and 4 and page 2 paragraphs 6-10. Since the user can either create a brand new station, or the user can take a shortcut by using a pre-formatted station and modifying it, the station changes which songs are played on the station so that content played on one station is different than the content played on another station per page 1 paragraphs 3 and 4 and page 2 paragraphs 6-10.

13. Applicant also argues that the user does not provide the content of the songs but rather the server provides the songs. With respect to this argument, in

reference to the Yamanaka and ImgRadio references, the Applicant is making arguments against the references individually. Specially, the Applicant is arguing that ImgRadio does not teach the user does not provide the content of the songs but rather the server provides the songs. As addressed above, Yamanaka teaches this limitation a receiving section that receives digital content from one of the users via the first user terminal wherein the users are different from the identified content proprietors (page 8 paragraphs 138 and 139, page 11 paragraph 190, page 20 paragraph 343, and Figure 15). The Examiner would like to point out to the Applicant that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references **(Yamanaka and ImgRadio)**. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is the combination of these references that addresses the claim limitations, and therefore, each reference will not teach all the limitations on its own.

14. Applicant has not provided any arguments regarding why the combination of references would not have taught allowing the secondary work to be received, registered, and delivered to another user but has just made this generalized statement in his arguments. These limitations were all addressed in claims 1, 5, 9, and 13 above, and the Examiner would like to refer the Applicant to review the rejection for these claims above.

15. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The Examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The Central FAX Number for the organization where this application or proceeding is assigned is **571-273-8300.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

N.B.

January 1st, 2008

RAQUEL ALVAREZ
PRIMARY EXAMINER